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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,098	10/14/2003	Nobuhiro Itoh	2271/71239	4451
7590 Ivan S. Kavrukov, Esq. Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036		08/22/2007	EXAMINER PACHOL, NICHOLAS C	
			ART UNIT 2609	PAPER NUMBER
			MAIL DATE 08/22/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/685,098

Applicant(s)

ITOH, NOBUHIRO

Examiner

Nicholas C. Pachol

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>ALL</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. Claims 24-33 are rejected under 35 U.S.C. 101 because the claimed invention is directly non-statutory subject matter.

Claims 24-33 claim a computer-readable storage medium, which stores a program (functional descriptive material) for causing a computer to carry out facsimile functions comprising... However, the claims do not define a computer-readable medium to be a memory/disk and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized").

Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory, under the present USPTO Interim Guidelines, 1300 Official Gazette Patent and Trademark Office 142 (Nov. 22, 2005).

The Examiner suggests amending the claim to include the disclosed tangible computer readable media, while at the same time excluding the intangible media (non-functional descriptive), i.e., music.

For example:

Claim 24 with limitation "A computer-readable storage medium ***which stores a program*** for causing a computer to carry out facsimile functions, comprising:

a specific destination name storage ***procedure*** causing the computer to store destination names of specific destinations in a storage section;

a receiving end identifying ***procedure*** causing the computer to identify a receiving end by analyzing terminal information received from the receiving end when making a facsimile transmission to the receiving end;

a specific destination identifying ***procedure*** causing the computer to search from the storage section a destination name corresponding to the receiving end which is identified by the receiving end identifying section; and

a notifying ***procedure*** causing the computer to output a communication result notification indicative of a result of the facsimile transmission to the receiving end only when the specific destination identifying section finds the corresponding destination name in the storage section." should be changed to

-- A computer-readable storage medium storing a computer program for causing a computer to carry out facsimile functions, comprising:

a specific destination name storage step causing the computer to store destination names of specific destinations in a storage section;

a receiving end identifying step causing the computer to identify a receiving end by analyzing terminal information received from the receiving end when making a facsimile transmission to the receiving end;

a specific destination identifying step causing the computer to search from the storage section a destination name corresponding to the receiving end which is identified by the receiving end identifying section; and

a notifying step causing the computer to output a communication result notification indicative of a result of the facsimile transmission to the receiving end only when the specific destination identifying section finds the corresponding destination name in the storage section. --

Dependent claims 25-33 should also be changed accordingly so to properly reflect the change made in Independent claim 24.

Any amendment to the claims 24-33 should be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cairo (US 5,809,116) in view of Chen (US 2002/0094076).

Regarding Claim 1, Cairo teaches a facsimile apparatus (Column 5, lines 33-35) comprising: a receiving end identifying section to identify a receiving end by analyzing terminal information received from the receiving end when making a facsimile transmission to the receiving end (Figure 2, element 30 and Column 5, lines 39-42); and a notifying section to output a communication result notification indicative of a result of the facsimile transmission to the receiving end only when the specific destination identifying section finds the corresponding destination name in the specific destination name storage section (Column 5, lines 49-56 and Column 5, lines 59-66).

However Cairo does not teach a specific destination name storage section to store destination names of specific destinations and a specific destination identifying section to search from the specific destination name storage section a destination name corresponding to the receiving end which is identified by the receiving end identifying section.

Chen does teach a specific destination name storage section to store destination names of specific destinations (Page 1, Paragraph 25) and a specific destination identifying section to search from the specific destination name storage section a destination name corresponding to the receiving end which is identified by the receiving end identifying section (Page 1, Paragraph 25), therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Cairo with the teaching of Chen for the purpose of providing clarity in caller identification (Column 1, Paragraph 6).

Regarding Claim 2, Cairo further teaches wherein the notifying section outputs a communication result report for each facsimile transmission made to the receiving end having the corresponding destination name stored in the specific destination name storage section (Column 2, lines 49-54).

Regarding Claim 3, Cairo further teaches wherein the communication result report has contents and/or format set differently for each specific destination (Column 2, lines 50-54).

Regarding Claim 4, Cairo further teaches wherein the notifying section displays or prints the communication result report (Column 5, lines 62-67).

Regarding Claim 5, Chen further teaches wherein the notifying section outputs a transmission end sound for each facsimile transmission made to the receiving end having the corresponding destination name stored in the specific destination name storage section (Page 1, Paragraph 27).

Regarding Claim 6, Chen further teaches wherein the transmission end sound is set differently for each specific destination (Page 1, paragraph 26 where index code indicates that the sound can be different and Page 3, paragraphs 67-68).

Regarding Claim 11, Cairo teaches a facsimile apparatus comprising: receiving end identifying means for identifying a receiving end by analyzing terminal information received from the receiving end when making a facsimile transmission to the receiving end (Figure 2, element 30 and Column 5, lines 39-42); and notifying means for outputting a communication result notification indicative of a result of the facsimile transmission to the receiving end only when the specific destination identifying means finds the corresponding destination name in the specific destination name storage means (Column 5, lines 49-56 and Column 5, lines 59-66).

However Cairo does not teach a specific destination name storage means for storing destination names of specific destinations and specific destination identifying means for searching from the specific destination name storage means a destination name corresponding to the receiving end which is identified by the receiving end identifying means.

Chen does teach a specific destination name storage means for storing destination names of specific destinations (Page 2, Paragraph 51) specific destination identifying means for searching from the specific destination name storage means a destination name corresponding to the receiving end which is identified by the receiving end identifying means (Page 2, Paragraphs 42 and 43), therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Cairo with the teaching of Chen for the purpose of providing clarity in caller identification (Page 1, Paragraph 6).

Regarding Claim 12, Chen further teaches wherein the notifying means makes the communication report notification by one or an arbitrary combination of communication report notifications selected from a group consisting of outputting a communication result report, outputting a transmission end sound, and printing a stamp mark on a scanned document, for each facsimile transmission made to the receiving end having the corresponding destination name stored in the specific destination name storage means (Paragraph 28 and Paragraphs 72-74, where having the option to choose between a song and a display and none at all makes it inherit to have the choice of a stamp, a sound, or a result report).

Regarding Claim 14, Cairo teaches a facsimile communication method comprising: identifying a receiving end by analyzing terminal information received from the receiving end when making a facsimile transmission to the receiving end (Figure 1); and outputting a communication result notification indicative of a result of the facsimile transmission to the receiving end only when the corresponding destination name is found in the storage section (Figure 1 and Figure 2).

However Cairo does not teach storing destination names of specific destinations in a storage section and searching from the storage section a destination name corresponding to the receiving end which is identified.

Chen does teach storing destination names of specific destinations in a storage section (Page 2, Paragraph 51) and searching from the storage section a destination name corresponding to the receiving end which is identified (Page 2, Paragraph 57),

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therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Cairo with the teaching of Chen for the purpose of providing clarity in caller identification (Page 1, Paragraph 6).

Regarding Claim 15, Cairo further teaches wherein the outputting outputs a communication result report for each facsimile transmission made to the receiving end having the corresponding destination name stored in the storage section (Column 8, lines 5-15).

Regarding Claim 16, Cairo further teaches wherein the communication result report has contents and/or format set differently for each specific destination (Column 2, lines 50-54).

Regarding Claim 17, Cairo further teaches wherein the outputting displays or prints the communication result report (Column 8, lines 61-65).

Regarding Claim 18, Chen further teaches wherein the outputting outputs a transmission end sound for each facsimile transmission made to the receiving end having the corresponding destination name stored in the storage section (Page 1, Paragraph 27).

Regarding Claim 19, Chen further teaches wherein the transmission end sound is set differently for each specific destination (Page 1, paragraph 26 where index code indicates that the sound can be different and Page 3, paragraphs 67-68).

Regarding Claim 24, the computer readable storage medium which stores a program is treated as a method. Cairo does teach a receiving end identifying procedure causing the computer to identify a receiving end by analyzing terminal information received from the receiving end when making a facsimile transmission to the receiving end (Figure 1); and a notifying procedure causing the computer to output a communication result notification indicative of a result of the facsimile transmission to the receiving end only when the specific destination identifying section finds the corresponding destination name in the storage section (Figure 1 and Figure 2).

However Cairo does not teach a specific destination name storage procedure causing the computer to store destination names of specific destinations in a storage section and a specific destination identifying procedure causing the computer to search from the storage section a destination name corresponding to the receiving end which is identified by the receiving end identifying section.

Chen does teach a specific destination name storage procedure causing the computer to store destination names of specific destinations in a storage section (Page 2, Paragraph 51) and a specific destination identifying procedure causing the computer to search from the storage section a destination name corresponding to the receiving end which is identified by the receiving end identifying section (Page 2, Paragraph 57),

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therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Cairo with the teaching of Chen for the purpose of providing clarity in caller identification (Page 1, Paragraph 6).

Regarding Claim 25, Cairo further teaches wherein the notifying procedure causes the computer to output a communication result report for each facsimile transmission made to the receiving end having the corresponding destination name stored in the storage section (Column 8, lines 5-15).

Regarding Claim 26, Cairo further teaches wherein the communication result report has contents and/or format set differently for each specific destination (Column 2, lines 50-54).

Regarding Claim 27, Cairo further teaches wherein the notifying procedure causes the computer to display or print the communication result report (Column 8, lines 61-65).

Regarding Claim 28, Chen further teaches wherein the notifying procedure causes the computer to output a transmission end sound for each facsimile transmission made to the receiving end having the corresponding destination name stored in the storage section (Page 1, Paragraph 27).

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Regarding Claim 29, Chen further teaches wherein the transmission end sound is set differently for each specific destination (Page 1, paragraph 26 where index code indicates that the sound can be different and Page 3, paragraphs 67-68).

Regarding Claims 7, 20, and 30, Chen further teaches wherein the notifying section, as described in claims 1, 14, and 24, prints a stamp mark on a scanned document for each facsimile transmission made to the receiving end (Column 4, line 60 – Column 5, line 4 and Column 5, lines 33-38, where stamp mark can be anything printed on the scanned document, i.e. indicia of delivery) having the corresponding destination name stored in the specific destination name storage section (Column 2, lines 50-53).

Regarding Claims 8, 21, and 31 Chen further teaches wherein the stamp mark, as disclosed in claims 7, 20, and 30, is set differently for each specific destination (Column 2, lines 50-53).

Regarding Claims 9, 22, and 32 Chen further teaches wherein the notifying section, as described in claims 1, 14, and 24, makes the communication report notification by one or an arbitrary combination of communication report notifications selected from a group consisting of outputting a communication result report, outputting a transmission end sound, and printing a stamp mark on a scanned document, for each facsimile transmission made to the receiving end having the corresponding destination

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name stored in the specific destination name storage section (Paragraph 28 and Paragraphs 72-74, where having the option to choose between a song and a display and none at all makes it inherit to have the choice of a stamp, a sound, or a result report).

Regarding Claims 10,13, and 23, and 33 wherein the communication result report, the transmission end sound, and the stamp mark are set differently for each specific destination as described in claims 9, 12, 22, and 32, (see rejections for claim 3 for the communication result report, claim 6 for transmission end sound, and claim 8 for stamp mark as described in claims 9 and 12).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas C. Pachol whose telephone number is 571-270-3433. The examiner can normally be reached on M-F, Alternate Friday off, 7:30 a.m.-5 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hai Tran can be reached on 571-272-7305. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

N.C.P.
08/02/07


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